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PTOL-90A (Rev. 04/07)

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JEFFREY L. KODOSKY, and JACK E. MACCRISKEN
Appeal 2008-2897
Application 10/053,521[1]
Technology Center 2100

_____

Decided:[2] March 10, 2009

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Before JEAN R. HOMERE, JAY P. LUCAS, and THU A. DANG
Administrative Patent Judges.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

_____

[1] Filed on January 18, 2002. The real party in interest is National Instrument
Corp.

[2] The two-month time period for filing an appeal or commencing a civil
action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date
shown on this page of the decision. The time period does not run from the
Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 2 through 18. Claim 1 has been canceled. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Appellants' Invention

Appellants invented a system for selectively routing a request for input to a simulation program depending on whether the simulation mode of the program is turned on or off. (Spec. 8-9 and 12.) As depicted in Figure 2, upon receiving a request for input from a resource measurement control program (200), a first program (204) determines whether the system is in simulation mode. If it is, the first program (204) routes the request for input to the simulation program (202). If the system is not in simulation mode, the program routes the request to an input device (250). (*Id.*)

Illustrative Claim

Independent claim 2 further illustrates the invention. It reads as follows:

2. A system for performing a simulation, the system comprising:

a first program;

a measurement/control program;

a simulation program; and

an input device;

wherein the system can be configured to turn a simulation mode either on or off;

wherein the first program is operable to:

receive a request for input form the measurement/control program;

determine whether the system is in simulation mode; and

selectively route the request for input, depending on whether the system is in simulation mode, wherein selectively routing the request for input comprises:

routing the request for input to the simulation program if the system is in simulation mode;

routing the request for input to the input device if the system is not in simulation mode.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

| Blake | US 5,574,854 | Nov. 12, 1996 |
| Bilger | US 6,912,429 B1 | Jun. 28, 2005 |

Rejection on Appeal

The Examiner rejects the claims on appeal as follows:

Claims 2 through 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Blake and Bilger.

Appellants' Contentions

Appellants argue that the combination of Blake and Bilger does not render independent claim 2 unpatentable. (App. Br. 5-8, Reply Br. 2-3.) Particularly, Appellants argue that Blake does not selectively route a request received from a measurement control program to either a simulation program or an input device based on the state of the simulation mode of the system. (App. Br. 6, Reply Br. 2.) Rather, Blake's disclosure is limited to a Real-Time Logger that routes requests to a simulator regardless of the state of the state of the simulation mode of the system. (*Id.*) Further, Appellants argue that one of ordinary skill in the art would not have found sufficient rationale to combine the teachings of Blake with Bilger since the software program disclosed in Bilger has little to do with Blake's. (App. Br. 7-8.)

Examiner's Findings/Conclusions

The Examiner finds that Blake's disclosure of a Real-Time Logger that receives a request from an application program, and routes it to a simulation program teaches the selective routing, as recited in independent claim 2. (Ans. 8-9.) Further, the Examiner finds that Bilger's teaching of designating simulation modes of the Cross program complements Blake's

simulation program thereby permitting it from switching between modes.
(Ans. 3-4.) Consequently, the Examiner concludes that Bilger and Blake are
properly combined to render claim 2 unpatentable.

II.   ISSUE

Have Appellants shown that the Examiner erred in concluding that the
combination of Blake and Bilger renders the claimed invention
unpatentable? Particularly, the issue turns on whether the ordinarily skilled
artisan would have found that the proffered combination teaches a system
that can be configured such that a first program therein is operable to (1)
receive a request for input from a measurement control program, and (2)
selectively route the request to either a simulation program or an input
device depending on the state of the simulation mode of the system, as
recited in independent claim 2.

III.   FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance
of the evidence.

Blake

1.   As shown in Figure 23, Blake discloses a Real-Time Logger
(2302), upon intercepting or receiving from an application program (2301) a
service request intended to processed at an old server, routes the request to a

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simulation program (2303), which subsequently maps the request to a new server (2304). (Col. 49, ll. 56-64.)

Bilger

2.   Bilger discloses a home automation system that utilizes a computer replicated object sourcing and synchronization (CROSS) program for automatically controlling devices in a home. As shown in Figure 10, the system includes operation mode keys (82a, 82b) for setting the system to a partial simulation mode, and a full simulation mode, respectively. (Col. 22, ll. 17-30.)

IV.   PRINCIPLES OF LAW
Claim Construction

"[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.,* 415 F.3d 1303, 1312 (internal citations omitted). "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir.

1989)). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d at 1323.

<div align="center">Obviousness</div>

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

> Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The

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operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. at 1739). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1741).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d at 987-988; *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific

teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968).

V.   ANALYSIS

Independent claim 2 recites in relevant part a system that *can be configured* such that a first program therein *is operable to* (1) receive a request for input from a measurement control program, and (2) selectively route the request to either a simulation program or an input device depending on the state of the simulation mode of the system.

We first consider the scope and meaning of the cited phrase, which must be given its broadest reasonable interpretation consistent with Appellant's disclosure. We note that the recitations "*can be configured,*" and "*is operable*" are not positive limitations. Stated differently, the recited limitations merely require the system to be *capable of being configured* such that the program *is capable of operating* to perform the afore-cited functions. Therefore, these recitations are simply statements of intended use, which should be afforded no patentable weight. See MPEP § 2114.

A statement of intended use in an apparatus claim cannot be used to distinguish the claim over the prior art apparatus. See *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). A claimed apparatus must be described by its structure, not its intended use. The mere recitation of an intended use in a

claim will not be given any patentable weight. *Application of Dense*, 156
F.2d 76, 77 (CCPA 1946). *See also Ex Parte James A. Satchell*, Appeal
2008-0071, 2008 WL 4828136, (BPAI 2008).

Therefore, we find that while the first program is *capable of operating*
to perform these recited functions, it is not actually performing the claimed
functions. Thus, Appellants improperly sought to patentably distinguish the
claimed system over the proffered combination of references based on the
intended use of the system and the program therein as opposed to their
respective structures. Accordingly, Appellants' argument that the
combination of Blake and Bilger does not teach the recited functions is not
commensurate in scope with the claim.

As set forth in the Findings of Facts section, Blake teaches that, upon
receiving an input request from an application, a Real-Time Logger routes
the request to a simulation program. (FF. 1.) Further, Bilger teaches a
mechanism for selecting between a full simulation mode and a partial
simulation mode in the CROSS program. (FF. 2.) We find that the
combined disclosures of Blake and Bilger, at best, teach or suggest that the
Real-Time Logger routes a received input from the application program to
selectively run the simulation program in either full mode or partial mode.

While we agree with Appellants that the proffered combination falls
short of suggesting selectively routing the request between the simulator and
the input device based upon the simulation state of the system, we find that

the claim does not require such limitation. Consequently, we are constrained to sustain the Examiner's rejection since Appellants' argument fails to be commensurate in scope with the claim.

In deciding this appeal, we have considered only those arguments that Appellants submitted in the Appeal and Reply Briefs. Arguments not submitted herein are deemed to have been waived. *See* 37 CFR 41.37(c)(1)(vii)(eff. Sept. 13, 2004). *See also In re Watts*, 354 F.3d 1362, 1368, (Fed. Cir. 2004). It follows that Appellants have not shown that the Examiner erred in concluding that the combination of Blake and Bilger renders claim 2 unpatentable.

Appellants did not provide separate arguments with respect to the rejection of claims 3 through 18. Appellants are reminded that merely repeating the language of the claim does not constitute a separate argument. Therefore, we select independent claim 2 as being representative of the cited claims. Consequently, claims 3 through 18 fall together with representative claim 2. 37 C.F.R. § 41.37(c)(1)(vii).

VI. CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in concluding that the combination of Blake and Bilger renders claims 2 through 18 unpatentable.

VII. DECISION

We affirm the Examiner's decision to reject claims 2 through 18.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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